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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,033	10/22/2001	Patrick C. Kung	044574-5040	9303

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EXAMINER

LY, CHEYNE D

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/11/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/830,033

Applicant(s)

KUNG ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 24-76 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for ~~domestic~~ priority under 35 U.S.C. ~~§§ 120 and/or 121~~ 371.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1631

### **DETAILED ACTION**

The art unit designated for this application has changed. Applicants(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

#### **Lack of Unity**

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
  - I. Claim(s) 24-26, 30-34, 65-67, and 70-75; drawn to a method of establishing a standardized herbal bioresponse array for an herbal composition classified in class 702, subclass 19. If this Group is elected, then the below summarized 3 species sets (plant-related data, BioResponses and biosystems), election of a species from each set is required.
  - II. Claim(s) 27-34, 68, 69 and 70-75; drawn to a method of evaluating an herbal composition, classified in class 702, subclass 19. If this Group is elected, then the below summarized 3 species sets (plant-related data, BioResponses and biosystems), election of a species from each set is required.
  - III. Claim(s) 35-47, 64 and 76; drawn to a method for predicting the biological activity of an herbal composition, classified in class 702, subclass 19. If this Group is elected, then the below summarized 3 species sets (plant-related data, BioResponses and biosystems), election of a species from each set is required.

Art Unit: 1631

- IV. Claim(s) 48-52, drawn to a method of determining if an herbal composition meets a standard specification, classified in class 702, subclass 19. If this Group is elected, then the below summarized 3 species sets (plant-related data, BioResponses and biosystems), election of a species from each set is required.
- V. Claim(s) 53-60, drawn to a method of adjusting the components of an herbal composition so that it meets a standard specification, classified in class 702, subclass 19. If this Group is elected, then the below summarized 3 species sets (plant-related data, BioResponses and biosystems), election of a species from each set is required.
- VI. Claim(s) 61-63 and 70-75, drawn to a method of obtaining a set of discriminating molecular markers for an herbal composition, classified in class 702, subclass 19. If this Group is elected, then the below summarized 3 species sets (plant-related data, BioResponses and biosystems), election of a species from each set is required.

**Specie Election Requirement For Groups I-VI:**

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.
5. Species of plant-related data are cited in claim 32, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select a type of plant-related data from those listed in claim 32 and thereof.
6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

Art Unit: 1631

held to be allowable. Currently, Groups I-VI are generic to the above species of plant-related data.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

**Specie Election Requirement For Group I-VI:**

7. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

8. Species of BioResponses are cited in claim 33, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select a type of BioResponses from those listed in claim 33.

9. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Groups I-VI are generic to the above species of BioResponses.

Art Unit: 1631

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

**Specie Election Requirement For Group I-VI:**

10. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.
11. Species of biosystems are cited in claim 34, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select a type of biosystem from those listed in claim 34.
12. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Groups I-VI are generic to the above species of biosystems.
13. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An

Art Unit: 1631

argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

14. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

15. The inventions listed as Groups I - VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is directed to a method of establishing a standardized herbal bioresponse array for an herbal composition. Group II is directed to a method of evaluating an herbal composition. Group III is directed to a method for predicting the biological activity of an herbal composition. Group IV is directed to a method of determining if an herbal composition meets a standard specification. Group V is directed to a method of adjusting the components of an herbal composition so that it meets a standard specification. Group VI is directed to a method of obtaining a set of discriminating molecular markers for an herbal composition. Clearly, these six groups with their respective technical features are distinct from each other. Thus, Groups I-VI are directed to different special technical features and thus support this lack of unity.

16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1631

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### CONCLUSION


18. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

21. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
3/9/03

  
ARDIN H. MARSCHER  
PRIMARY EXAMINER